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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,667	03/02/2004	John K. Roberts	GEN10 P-333A	2723

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EXAMINER	
SEMBER, THOMAS M	
ART UNIT	**PAPER NUMBER**
2875	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,667	ROBERTS ET AL.	
	Examiner	Art Unit	
	Thomas M. Sember	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *07/19/04*
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

References JP62-235787, JP62-18775 and DE 3916875 cited in the information disclosure statement filed 0n 07/19/04 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The applicant merely states that references JP62-235787, JP62-18775 and DE 3916875 are LED assemblies. However, the examiner has no information if these LED assemblies read on applicant's claims.

"The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office.
The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims.
However, see Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.,

204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) ("[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference."

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15 "said radiation source" is indefinite because it is not clear which light source applicant is referring to.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 12-18 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-156 of copending Application No. 11/005,459. The applicant merely uses slightly different claim language to claim the same invention. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-156 of copending Application No. 11/005,459 in view of (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179.) Claims 1-156 of copending Application No. 11/005,459 teach the claimed invention except for the teaching that the light emitters are combined together to form white light and one light source is photoluminescent or fluorescent source. Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) teaches light emitters (including a photoluminescent source or fluorescent source) which are combined to create efficient white light. It would have been obvious to one skilled in the art at the time the invention was made to combine two light emitters, one being a photoluminescent of fluorescent material, to form white light since (Shimizu et al '440 or

Reeh et al '500 or Shimizu et al '179) teaches that it would be advantageous to create efficient white light.

Claims 1-3, 12-18 and 20 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 6,828,170, claims 1-17 of U.S. Patent No. 6,670,207, claims 1-74 of U.S. Patent No. 6,335,548 in view of JP3016636. Claims 1-43 of U.S. Patent No. 6,828,170, claims 1-17 of U.S. Patent No. 6,670,207, claims 1-74 of U.S. Patent No. 6,335,548 teach the claimed invention except for the teaching that the Light emitters are combined together to form white light. JP3016636 teaches combining two LED light sources which are combined to create efficient white light. It would have been obvious to one skilled in the art at the time the invention was made to combine two light emitters or LEDs together to form white light since JP3016636 teaches that it would be advantageous to use two LEDs to create efficient white light.

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 6,828,170, claims 1-17 of U.S. Patent No. 6,670,207, claims 1-74 of U.S. Patent No. 6,335,548 in view of (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179.) Claims 1-43 of U.S. Patent No. 6,828,170, claims 1-17 of U.S. Patent No. 6,670,207, claims 1-74 of U.S. Patent No. 6,335,548 teach the claimed invention except for the teaching that the light emitters are combined together to form white light and one light source is photoluminescent or

fluorescent source. Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) teaches two light emitters (including a photoluminescent source or fluorescent material which are combined to create efficient white light. It would have been obvious to one skilled in the art at the time the invention was made to combine two light emitters or LEDs together to form white light since (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) teaches that it would be advantageous to create efficient white light.

Claim Rejections - 35 USC § 102

This application is a CIP of parent applications 09/148,375, 09/604,056 and 08/664,055. The applicant is reminded that he can only claim priority benefit back to the material that was disclosed in the prior applications. Since a photoluminescent material combined with solid state light source to create white light was not taught in the previous applications mentioned above, the examiner will use the filing date of 11/28/2000 as the earliest date for that claimed subject matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 12-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al (U.S. Publication 2005/0077623 priority back to Oct 22, 1999). U.S. application 10/791,667 only has priority back to 11/28/2000 where applicants add the heat extraction details.)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 12-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino et al in view of JP3016636. Ogino et al teaches the claimed invention except for the teaching that the Light emitters or LEDs are combined together to form white light. JP3016636 teach light emitters (LEDs) which are combined to create efficient white light. It would have been obvious to one skilled in the art at the

time the invention was made to modify the LEDS of Ogino et al so as to combine two light emitters or LEDs together to form white light since JP3016636 teaches that it would be advantageous to create efficient white light.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 12-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP3016636 in view of Ogino et al. JP3016636 teaches the claimed invention except for the teaching of a heat extraction means for the LEDs. Ogino et al teaches a heat extraction means for LEDs. Ogino et al discloses a heat extraction element 3 and lead frame. A mounting plate 2 and 3 and a wire connect to lead 4b. The mounting plate has a greater thickness in the directon normal to heat transfer through heat extraction element 3 including fins 3a. It would have been obvious to one skilled in the art at the time the invention was made to modify the LED device of JP3016636 to include the heat extraction means of Ogino et al in order to efficiently extract heat from the light emitter.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179.) in view of Ogino et al. JP3016636 teaches the claimed invention except for the teaching of a heat extraction means for the LEDs. Ogino et al teaches a heat extraction means for LEDs. Ogino et al discloses a heat extraction element 3 and lead frame. A mounting plate 2/3 and a wire connect to lead 4b. The mounting plate has a greater thickness in the direction normal to heat transfer through heat extraction element 3 including fins 3a. It would have been obvious to one skilled in the art at the time the invention was made to modify the LED device of (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179.) to include the heat extraction means of Olgino et al in order to efficiently extract heat from the light emitter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino et al in view of (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179.) Ogino et al teaches the claimed invention except for the teaching that the light emitters

are combined together to form white light and one light source is photoluminescent or fluorescent source. (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) teaches light emitters (including a photoluminescent source or fluorescent source) which are combined together to create efficient white light. It would have been obvious to one skilled in the art at the time the invention was made to combine two light emitters or LEDs together to form white light since (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) teach that it would be advantageous to create efficient white light.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) in view of Ogino et al. (Shimizu et al '440 or Reeh et al '500 or Shimizu et al '179) teaches the claimed invention except for the teaching of a heat extraction means for the LEDs. Ogino et al teaches a heat extraction means for LEDs. Ogino et al discloses a heat extraction element 3 and lead frame. A mounting plate 2 and 3 and a wire connect to lead 4b. The mounting plate has a greater thickness in the direction normal to heat transfer through heat extraction element 3 including fins 3a. It would have been obvious to one skilled in the art at the time the invention was made to modify the LED device of (Shimizu et al

'440 or Reeh et al '500 or Shimizu et al '179) to include the heat extraction means of Ogino et al in order to efficiently extract heat from the light emitter.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Butterworth et al discloses an LED device which si similar to applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 8 A.M- 5.30 p.m. first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas M Sember
Primary Examiner
Art Unit 2875

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